

ADMINISTRATIVE PANEL DECISION

Peter Thomas Roth Labs LLC v. 魏建东 (JianDong Wei)
Case No. D2024-1482

1. The Parties

The Complainant is Peter Thomas Roth Labs LLC, United States of America (“United States”), represented by Mintz Levin Cohn Ferris Glovsky and Popeo, P.C., United States.

The Respondent is 魏建东 (JianDong Wei), China.

2. The Domain Name and Registrar

The disputed domain name <peterthomasrothus.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2024. On April 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 10, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown Cybersquatter) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 11, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On April 12 and 15, 2024, the Complainant submitted two amended Complaints in English respectively, and on April 16, 2024, the Complainant submitted a Chinese translation of the amended Complaint. The Complainant sent an email to the Center on April 17, 2024, requesting English be the language of proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amended Complaints and the translated Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in Chinese and English of the Complaint, and the proceedings commenced on April 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 10, 2024.

The Center appointed Tao Sun as the sole panelist in this matter on May 28, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is the owner of the PETERTHOMASROTH trademark. It uses this mark in commerce and in connection with the sales of the products, including non-medicated skin care and hair care preparations, sun care and sun tanning preparations, self-tanning preparations, cosmetics, shaving preparations, and fragrance in the United States and worldwide. It has become an established leader in the skin care industry.

The Complainant submits its United States registration No. 4755319 PETERTHOMASROTH in class 3, registered on June 16, 2015.

The Complainant has operated a website at "www.peterthomasroth.com" to promote its products with the PETERTHOMASROTH trademark.

The disputed domain name was registered on February 29, 2024. According to the evidence submitted by the Complainant, it resolves to a website purportedly offering skincare products with the PETERTHOMASROTH brand. In the screenshot submitted by the Complainant, the Complainant's PETERTHOMASROTH trademark is prominently used in the same way as the website of the Complainant, the products bearing the PETERTHOMASROTH trademark are displayed, and there is "Peterthomasrothus – Official Store" statement in the heading of the webpage.

The Respondent is 魏建东 (JianDong Wei), a Chinese individual.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- (i) the disputed domain name incorporates the Complainant's entire PETERTHOMASROTH name and mark, and as such is confusingly similar to the Complainant's name and mark.
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent's use of the disputed domain name is clearly intended to confuse the public as to the source of the Respondent's goods and at the very least suggest an affiliation or relationship with approval by, the Complainant. Neither can the Respondent make any showing of legitimate interests in the disputed domain name. The only use of the disputed domain name that the Respondent has made has been in connection with a webpage, the sole purpose of which is to attract Internet users to its website to sell counterfeit goods and/or to collect user information. The Respondent's use of the disputed domain name is creating consumer confusion as to the source of its goods and services and suggests a sponsorship or approval by the Complainant that the Respondent does not have. As such, the Respondent's use of the disputed domain name does not amount to a legitimate business purpose.

(iii) the Respondent clearly registered the disputed domain name, which is confusingly similar to the Complainant's PETERTHOMASROTH name and mark, in a bad faith attempt to trade on the Complainant's reputation and goodwill. When the circumstances surrounding the Respondent's registration and use of the disputed domain name are taken into consideration, there can be no question that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant submitted the amended Complaints in English together with the Chinese translation. The Complainant requested that the language of the proceeding be English.

The Respondent did not submit any response including the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters in this case, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English, considering the factors that:

a) disregarding the generic Top-Level Domain ("gTLD"), the disputed domain name is similar to the Complainant's trademark and consists of Latin letters, and the contents of the website at the disputed domain name are in English, indicating that the Respondent has a certain level of understanding of English; and

b) The Respondent did not make any comments on the language of the proceeding.

6.2 Substantive Issues

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term “us” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. Furthermore, the Panel finds the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

It seems from the screenshots of the website at the disputed domain name that the Respondent is purportedly offering for sale the skin care products bearing the PETERTHOMASROTH trademark. The Complainant asserts that the website brings the users to various counterfeiting products but did not provide evidence. However, the Panel maintains that, even if the Respondent is offering for sale the genuine products, the use of the disputed domain name could not be regarded as a bona fide offering of goods and thus to confer on the Respondent a right or legitimate interest in the disputed domain name. As outlined in the “Oki Data Test” (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), it has been well-established that one of the requirements of a bona fide offering of goods is that the site must accurately and prominently disclose the registrant’s relationship with the trademark owner. In this case, instead of accurately and prominently disclosing the Respondent’s relationship with the Complainant, the website at the disputed domain name prominently uses the Complainant’s trademark and displays “Peterthomasrothus – Official Store” statement in the heading of the webpage, suggesting it is the official website of the Complainant. Such uses will inevitably confuse the consumers and therefore can not confer rights or legitimate interests on the Respondent. [WIPO Overview 3.0](#), section 2.8.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Panels have consistently found that mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4). In this case, considering the reputation of the PETERTHOMASROTH trademark and the Respondent's use of the Complainant's trademark on the website at the disputed domain name, the Panel finds that the Respondent knew of the Complainant and deliberately registered the disputed domain name in bad faith.

Moreover, the Respondent has resolved the inherently misleading disputed domain name to a website purportedly offering for sale skin care products bearing the PETERTHOMASROTH trademark and claiming itself as the "official store." In light of the above, and based on the case file, the Panel finds that the Respondent was aware of the Complainant and intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Respondent's failure to file any formal response also supports a finding of bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <peterthomasrothus.com> be transferred to the Complainant.

/Tao Sun/

Tao Sun

Sole Panelist

Date: June 5, 2024